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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFAN KASTNER

Appeal 2009-013038
Application 10/019,706
Technology Center 3700

Before RICHARD E. SCHAFER, SALLY C. MEDLEY and
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

TIERNEY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

A. STATEMENT OF THE CASE

This is a decision on appeal by the real party in interest, Hydro Aluminum Deutschland GmbH (“Hydro”), under 35 U.S.C. § 134(a), from a final rejection of claims 6-17, the only claims on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

References Relied on by the Examiner

Gaul	U.S. 2,800,709	July 30, 1957
Hu	CN 1105615 A	July 26, 1995

The Invention

This invention is directed to a method for producing an aluminum composite material (Spec. 1:4-6). The composite is made by placing a sheet of aluminum on an aluminum ingot of different composition and rolling the combination to bond the cladding sheet to the ingot. The method also requires that the aluminum sheet be longitudinally cut from another ingot using a saw. (Spec. 4:26-33, App. Br. 9 and Reply Br. 4).

Independent claim 6, which is illustrative of the claimed invention, is reproduced below (emphasis added):

6. A method for producing an aluminum composite material comprising:
 - sawing at least one cladding layer of a specified thickness suitable for use as a cladding layer from a first ingot made from a first aluminum material in a longitudinal direction;
 - placing said cladding layer on a side of a second ingot made from a second aluminum material; and
 - rolling said cladding layer and said second ingot, said rolling comprising several roll passes thereby producing said aluminum composite material. (App. Br. Claims App’x 14).

The Rejection on Appeal

The Examiner rejected claims 6-17 under 35 U.S.C. § 103(a) as being obvious over Gaul in view of Hu (Ans. 3). Hydro argued these claims as a single group. We exercise our discretion and select independent claim 6 for review with claims 7-17 standing or falling with claim 6 (37 C.F.R. § 41.37(c)(1)(vii)).

B. ISSUE

Would it have been obvious to one of ordinary skill in the art at the time of the invention to form an aluminum cladding layer by sawing it from an ingot when it was known in the art to saw metal?

C. FINDINGS OF FACT

1. Gaul is directed to the manufacture of aluminum composite material by attaching “plates or liners of one metal to ingots of the other metal” (Gaul 1:15-25).
2. Gaul teaches that the combination of the liner and ingot is rolled together in several passes to produce a composite material (Gaul 4:70 to 5:9).
3. Hu teaches a method of using a band saw to longitudinally cut a metal ingot (Hu Abst.).
4. Hu states that sawing metals provides for lower costs, lower material consumption and reduced contamination as compared to existing techniques, such as rolling metals (Hu Abst.).

D. PRINCIPLES OF LAW

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

E. ANALYSIS

The Examiner contended that Gaul discloses the production of aluminum composite material involving the placement of a thinner cladding layer onto an ingot and then rolling the combination together in several passes (Ans. 3). The Examiner acknowledged that Gaul does not disclose, “sawing the cladding layer from a first ingot....in a longitudinal direction” (*Id.*). The Examiner cited Hu however as disclosing, “sawing a metal ingot....in a longitudinal direction using a band saw” (*Id.*). The Examiner concluded that one skilled in the art would have obtained Gaul’s cladding layer using Hu’s sawing method in light of Hu’s teaching that sawing provides advantages compared with existing techniques (*Id.* at 3-4).

Hydro contends that there is no motivation to combine the references in the claimed manner. In particular, Hydro states that Gaul is not silent as to how its cladding was formed. Specifically, Hydro states that Gaul describes its liner as “liner stock” and from this Hydro speculates that “[o]ne skilled in the art would recognize that the cladding of Gaul is produced involving a process including hot-rolling.” (Reply Br. 4). Hydro goes on to contend that, assuming that the teachings of Gaul are limited to hot rolling,

one skilled in the art lacked a reason to employ Hu's sawing technique with Gaul's process. (Reply Br. 4-5).

Gaul does not identify how its metal plates and liners are formed and Hydro does not cite to any evidence to support its position that one skilled in the art would understand that Gaul is limited to using metal plates and liners obtained from a hot rolling process. On this record we decline to credit Hydro's unsupported attorney argument that Gaul's liner is limited to hot rolling processes. *Estee Lauder, Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (attorney argument cannot take the place of evidence in the record).

Hydro also contends that Hu is limited to a steel ingot and that Gaul does not disclose that the sheet, plate or liner can be formed from an aluminum ingot. (App. Br. 10). We agree that Gaul does not specifically teach forming a plate or liner from an aluminum "ingot" and that steel and aluminum have differing physical properties. Obviousness however, is not limited to the express teachings of a single prior art reference but is based upon what the combined teachings of the prior art suggest to the person of ordinary skill in the art. *Keller*, 642 F.2d at 425. Here, Gaul teaches forming a composite from an aluminum plate (Gaul 3:47-50). Hu teaches that sawing metal for metal fabrication provides advantages (reduced material consumption and surface contamination) as compared to prior techniques (Hu Abst.). Further, while Hu is specifically directed to "steel," Hydro has failed to demonstrate that one skilled in the art would fail to understand that the advantages identified in Hu, with respect to sawing, would not also apply to other metals, such as aluminum. Accordingly, we hold that Hydro's claims are directed to the use of known composite forming

techniques (cladding and sawing) for their known purpose to achieve a predictable result (forming a composite).

Hydro further contends that if Gaul and Hu were combined, Gaul would no longer function for its intended purpose since the thinner steel layer of Hu would not spread out onto the larger aluminum ingot of Gaul during rolling (App. Br. 12). The Examiner's rejection is that one skilled in the art would use the sawing technique of Hu to saw an aluminum ingot to form a liner, which then is used to clad a separate aluminum ingot, as taught by Gaul (Ans. 5-6). Accordingly, we need not determine whether a steel layer would be an effective cladding for an aluminum ingot.

We affirm the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as obvious over Gaul in view of Hu. As claims 7-17 stand or fall with claim 6, we likewise affirm the Examiner's rejection of claims 7-17.

F. CONCLUSION OF LAW

It would have been obvious to one of ordinary skill in the art at the time of the invention to form an aluminum cladding layer by sawing it from an ingot when it was known in the art to saw metal.

G. ORDER

The rejection of claims 6-17 under 35 U.S.C. § 103(a) as being obvious over Gaul in view of Hu is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Appeal No. 2009-013038
Application No. 10/019,706

bim

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